

## REMARKS

In accordance with the foregoing, the preambles of claims 1, 24 and 28 have been amended to make clear that each claim relates to a surface discharge type AC color plasma display panel substrate assembly, thereby to remove any suggestion that the preambles constitute mere statements of intended use.

No new matter is presented and, accordingly, approval and entry of the foregoing claim amendments are respectfully requested.

### **Entry of the claim amendments is submitted to be proper**

The amendments to claims 1, 24 and 28 do not raise any new issues since merely placing these claims in the same condition as claim 14, which has already been allowed.

The amendments moreover simplify the issues on appeal, should the Examiner not be inclined to allow the claims in their currently amended forms, and accordingly should be entered as a matter of right.

Such actions are earnestly solicited.

### **Page 2 of the Action: Rejection of claims 1, 5, 19, 20 and 22-28 for anticipation under 35 USC §102(b) by Amano**

The rejection is respectfully traversed.

### **Conference with Examiner Santiago**

In a conference with Examiner Santiago on July 20, 2004, Applicants counsel urged that the decisions of In re Hirao and Kropa v. Robie, cited in the Response to Arguments at page 10 of the outstanding Final Office Action, are not properly cited since not supporting any broad proposition that preamble limitations are not entitled to patentable weight. Examiner Santiago on the other hand emphasized that in the preambles of rejected claims 1, 24 and 28, the recitation of "a substrate assembly for a surface discharge type AC color plasma display panel..." was in the nature of an "intended use of a structure..."

Examiner Santiago and the undersigned counsel for Applicants then resolved that the foregoing amendments to the preambles of claims 1, 24 and 28 would overcome that "intended use" basis of rejection and render those claims allowable, consistent with the allowance of claim 14.

Applicants' counsel also noted that claim 19 appears to have been rejected incorrectly on the overly broad interpretation of Kropa v. Robie and Examiner Santiago agreed to reconsider that circumstance.

### **The Holdings of In re Hiroa and Kropa v. Robie**

Applicants counsel pointed out that In re Hiroa is not germane to the issue of whether a preamble recitation is entitled to patentable weight and In re Hirao does not broadly treat preamble recitations as unentitled to patentable weight but, instead, supports an interpretation of preamble limitations as being entitled to patentable weight under circumstances of the claims herein as now amended.

### **Page 10 of Action: Response to Arguments**

The Examiner explains that the preamble recitation, of various independent claims, of "a surface discharge type AC color plasma display panel":

...[H]as not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. ... (citing cases).

The first case citation, In re Hirao, 190 USPQ 15 (CCPA 1976), is respectfully submitted to be irrelevant to the issues addressed in the In re Hirao decision.

The only portion of the decision which even refers to the preamble of the claim arises in the court's observation that an argument of the Solicitor was to the effect that the recitation of the preamble showed "that the subject matter as a whole involves the use of an old sweetening agent in a very obvious manner." The court responded:

"However, the preamble merely recites the purpose of the process; the remainder of the claim (the three process steps) does not depend on the preamble for completeness, and the process steps are able to stand alone." See Kropa v. Robie...

Kropa v. Robie, also cited in the Examiner's Response, held that a clause in a claim preamble of "An abrasive article" was to be given the effect of a limitation, since:

"...deemed essential to point out the invention defined by the claim or count..."  
[T]he preamble was considered necessary to give life, meaning and vitality to the claims or counts... [T]here inhered in the article specified in the preamble a problem which transcended that before prior artisans and the solution of which was not conceived by or known to them.

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Thus, the specific ruling of Kropa is that a preamble of "an abrasive article..." was to be given "patentable weight"--contrary to the manner in which Kropa is cited in the Examiner's response.

### Conclusion

In accordance with the foregoing, it is respectfully submitted that the pending claims patentably distinguish over the references of record and, there being no other objections or rejections, that the application is condition for allowance, which action is earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date:

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